

REMARKS

At the outset, it should be noted that non-elected claims 1-6 and 29-39 have been canceled.

In ¶ 4 of the Office Action, claim 22 was objected to under 37 CFR 1.75(c) as being improperly dependent on itself. This discrepancy has been corrected by amending claim 22 to depend from claim 18.

In ¶ 6 of the Office Action, claims 16, 17, 19-21, 24, 40, 41, 43-45, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Meihofer (US 3,912,145). The Applicant traverses this ground of rejection for the following reasons.

Independent claims 16 and 40 have been amended to clarify that the torque control device acts on one roller of a pair of rollers that form a nip located downstream of a dancer assembly, as opposed to upstream of a dancer assembly, as taught by Meihofer. Meihofer is directed toward changing the web tension as needed to reposition the dancer assembly to its reference position. Meihofer further discloses a cylinder 44 that exerts a torque on the dancer assembly, the latter comprising a pair of parallel rolls journaled in a pair of end plates, which are in turn journaled in a pair of bearing assemblies. "The dancer assembly shown in FIG. 1 maintains constant web tension with a constant loading force from cylinder 44 through all positions of the dancer assembly" [col. 6, lines 26-29] The control section 16 responds to the dancer

motion by applying a drive torque or a holdback torque to the draw roll 10, which in turn decreases or increases the tension in the web W entering the dancer assembly as needed to return the dancer assembly to its reference position. [col. 5, lines 16-21] This arrangement bears little resemblance to the apparatus recited in amended independent claims 16 and 40, wherein torque control device applies an output torque having a magnitude sufficient to produce a desired tension in that portion of the second elongated continuous structure disposed between the nip and a joining station. Therefore, claims 16 and 40 (and claims dependent thereon) are not obvious over the AAPA in view of Meihofer.

In ¶ 7 of the Office Action, claims 16-23 and 40-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinigakis *et al.* (US 6,675,558) in view of Meihofer (US 3,912,145). The Applicant traverses this ground of rejection for the same reasons (regarding the differences between Applicant's invention and the apparatus of Meihofer) given in the preceding paragraph and the additional reason that it would not have been obvious to combine the teachings of Kinigakis and Meihofer due to a lack of any motivation for the proposed combination.

To establish a *prima facie* case of obviousness, three basic criteria must be met by the Examiner, as set forth at MPEP 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second,

there must be a reasonable expectation of success. Finally, the combined prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. Applicants apply these criteria below to show that a *prima facie* case of obviousness has not been established.

In the first place, the third criterion has not been met in the office action. It is well settled that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03 further states: "When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight, ...". The instant office action does not take into account the limitation, added to claims 16 and 40 by amendment, that the torque control device applies an output torque to one roller of a pair of rollers that form a nip downstream of a dancer assembly.

Furthermore, the Examiner has also failed to satisfy the criterion that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the instant patent application, this criterion cannot be met. The Kinigakis reference teaches the manual adjustment of zipper tension by means of a knob 352 (see Figure 43) that is turned to adjust the vertical position of an idler roller 280. The Examiner has not pointed to any part of the Kinigakis patent that would suggest the need to replace the manual adjustment of zipper tension with an automated system. This is especially true in light of the statement in Kinigakis calling for "simple tension adjustments". [col. 15, lines 1-2] Nor has the Examiner appreciated that the web tension control system of Meihofers is designed for use with a web, not a continuous zipper material comprising interlocked continuous zipper strips. The Examiner has given no consideration to what modifications would be needed to the apparatus of Meihofers to render it suitable for use with interlocked continuous zipper strips of the type seen in Kinigakis. Absent a showing that Meihofers is suitable for use in the system of Kinigakis, the Applicant submits that no motivation for combining the teachings of these references has been shown.

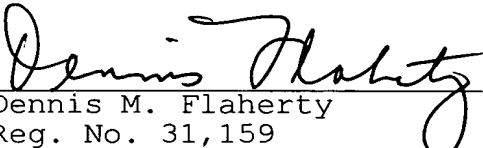
In view of the foregoing, the Applicants submit that the obviousness rejection based on Kinigakis in view of Meihofers should be withdrawn.

Finally, claims 22 and 46 stand rejected as being obvious over Kinigakis in view of Meihofers, and further in view of Buchman (US 6,517,242). The Applicant also traverses this ground for rejection and submits that claims 22 and 46 are patentable at least for the same reasons, set forth above, that claims 16 and 40, on which they respectively depend, are patentable.

In view of the foregoing, the Applicant submits that this application is now in condition for allowance. Reconsideration of the application and allowance of claims 16-24 and 40-48 are hereby requested.

Respectfully submitted,


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Date


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